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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,184	12/01/2003	Brian K. Revill	050885-0306961	1330
20583	7590	01/05/2007		
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			EXAMINER PATEL, VISHAL A	
			ART UNIT	PAPER NUMBER
			3673	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/724,184

Applicant(s)

REVILL ET AL.

Examiner

Vishal Patel

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7,9,10,12,15-18,22,23,27 and 29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2,4,7,9,10,12,15-18,22,23,27 and 29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4, 7, 9, 10, 12, 15-18, 22-23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (US. 5,035,185) in view of Breaker (US. 5,518,257) and further in view of Jelinek (US. 4,026,565).

Schultz discloses a gasket having a substantially square or rectangular unitary frame comprised of a plasticized resin and having an inner peripheral edge (inner edge 30), an outer peripheral edge (outer edge 32), an upper surface and a lower surface (upper and lower surfaces of 12) and the inner peripheral edge including a nose or protrusion (nose or protrusion 20) comprised of the resin wherein the nose or protrusion projects beyond the upper or the lower surfaces. The frame is formed as an integral unitary structure by welding at corners 16. The gasket is provided with holes (holes 18) to accommodate sealing bolts. The protrusion or nose extends around substantially the entire perimetral length of the frame and having a shape.

Regarding claim 15-18: The gasket of Schultz is capable of being placed on another gasket. the nose is provided on opposite sides thereof (the nose or protrusion is on the upper and lower surfaces of the gasket). The at least one side of the gasket is planar and wherein the frame is locally enlarged at its inner peripheral edge to form the nose which projects beyond the plane of the gasket on the at least one side thereof to effect sealing contact (method limitations given

little patentable weight in an apparatus claim). Furthermore Schultz teaches to have the nose or protrusion on the inner peripheral edge of the frame. The cross-section of the frame is of rectangular cross-section with the dimension perpendicular to the gasket plane being smaller than the dimension in the plane of the gasket (figure 3).

Schultz discloses the invention substantially as claimed above but fails to disclose that the frame is formed as a monolithic frame. One-piece construction, in place of separate elements forming a whole is well known to one skilled in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the integral frame of Schultz to be formed as a monolithic frame, since providing one piece-construction in place of separate elements forming a single whole element is merely a matter of obvious engineering choice. In re Kohn, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965).

Schultz discloses the invention substantially as claimed above but fails to disclose that the inner peripheral edge is coated with a polytetrafluoroethylene liner. Breaker discloses a gasket having an inner peripheral edge (inner peripheral edge of 510) and a PTFE liner (526) is placed on the inner peripheral edge. The liner is substantially uniform thickness. The liner is placed on the inner peripheral edge and also on top and bottom surfaces of the gasket, which forms a U-shape liner. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the inner peripheral edge of Schultz to have a liner that is around the inner peripheral surface and top and bottom surfaces as taught by Breaker, to provide a protection against harsh environment for the gasket (function of PTFE).

Schultz and Breaker disclose the invention substantially as claimed above but fail to disclose that the inner peripheral edge is part-circular in cross-section and the nose or protrusion is of curved bulbous configuration. Jelinek disclose a frame that is formed by (63 or 45), the frame having an inner peripheral edge that is flat (42, figure 5) and the frame having an inner peripheral edge that is curved (62, figure 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the inner peripheral edge of Schultz and Breaker to be curved as taught by Jelinek, since having a flat edge or curved edge is considered to be art equivalent.

3. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz and Breaker.

Schultz, Breaker and Jelinek disclose the claimed invention except for the resin to be EPDM. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the resin of Schultz and Breaker to be EPDM resin, since it has been held to be within the general skill of a worker in the art to select a know material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

4. Applicant's arguments filed 12/15/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the gasket is used for railroad hopper and not for sealing aggressive fluid, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicants' argument that the gasket of Schultz is directed to be used in railroad hopper car is not persuasive because Schultz, Breaker and Jelinek teach all the structural limitations of the claimed invention.

Applicants' argument to design choice is not persuasive because applicant has not provided any unaccepted results for forming the gasket in the form of a monolithic frame.

Furthermore applicants' argument that having flat edge or curved edge is not art equivalent is not persuasive because Jelinek teaches that flat edge or curved edge is art equivalent.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP
December 30, 2006



VISHAL PATEL
PRIMARY EXAMINER
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